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10/509,732	09/30/2004	Clarc J. Watkins	BJS-620-334	9948

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EXAMINER	
LEESER, ERICH A	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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OCT 17 2008

In re Application of :
Watkins et al :Decision on Petition
Serial No.: 10/509,732 :
Filed : 30 September 2004 :
Attorney Docket No.: 620-334 :

This letter is in response to the Petition under 37 C.F.R. 1.181 filed on 1 January 2008 requesting for withdrawal of the restriction requirement mailed 17 April 2007. The delay in acting on this petition is regretted.

BACKGROUND

This application was filed as a national stage application under 35 USC 371 and as such, is eligible for unity of invention practice.

On 17 April 2007, the examiner restricted claims 80-173 into 5 groups, depending upon the variable for the Cy residue.

On 17 May 2007, applicants elected with traverse, Group V, which is drawn to Cy variable which is defined as none of the Cy variables designated for Groups I-IV.

On 19 September 2007, in a non-final Office action, the examiner considered the traversal and made the restriction requirement FINAL. Claims 80-173 were rejected under 35 U.S.C. 112, 1st paragraph for lack of enablement. Claims 80, 118 and 142 were rejected under 35 USC 112, 2nd paragraph. Claims 80-71, 85, 98, 102, 116-117, 138-141, 145-146, 163-164 and 168 were rejected under 35 U.S.C. 102(b) as being anticipated by Bedell.

On 1 January 2008, applicants filed this petition.

On 18 January 2008, applicants filed an amendment to the claims and a response to the Office action.

On 5 May 2008, a final Office action was mailed in which the examiner maintained the enablement rejection. The rejection under 35 USC 102(b) as being anticipated by Bedell was withdrawn in view of the amendment to remove $C_{5\text{-}20arylene}$ from the definition of Q^2.

On 25 June 2008, applicant filed a response to the final Office action, including an amendment to add cancel claims 169-173.

On 3 September 2008, the examiner mailed a non-final Office action in which claims 80-84, 87-116 and 119-173 were rejected under 35 USC 112, 2nd paragraph. Claims 80, 81, 84, 98, 101, 116, 119-129, 135, 141-142, 145-146, 155-166 and 168 were rejected under 35 USC 103(a) as being unpatentable over Owen et al.

DISCUSSION

Applicants' petition and the file history have been considered carefully. The petition argues that the unity of invention determination was incorrect because Groups I-V share a special technical feature which makes a contribution over the prior art.

The PCT International search and preliminary examination guidelines, paragraph 10.03 provides that Lack of unity of invention may be directly evident "*a priori*," that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*," that is, after taking the prior art into consideration. Paragraph 10.03 goes on to state:

> For example, independent claims to A + X, A + Y, X + Y can be said to lack unity *a priori* as there is no subject matter common to all claims. In the case of independent claims to A + X and A + Y, unity of invention is present *a priori* as A is common to both claims. However, if it can be established that A is known, there is lack of unity *a posteriori*, since A (be it a single feature or a group of features) is not a technical feature that defines a contribution over the prior art.

Paragraph 10.03 also provides that whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," is considered with respect to novelty and *inventive step*. (emphasis added). "Inventive step" is a PCT phrase comparable to the obviousness standard used in US patent practice.

Applicants argue the claims are patentable over Bedell. This argument is convincing, in view of the withdrawal of the rejection under 35 USC 102(b) in the Office action dated 25 June 2008.

However, any technical feature shared among Groups I-V does not make a contribution over the prior art, as evidenced by the rejection of claims under 35 USC 103(a) as being unpatentable over Owen et al.

Furthermore, 37 CFR 1.475(b) provides guidance concerning various categories of invention permitted for national stage filings under 35 USC 371.

> 1.475 Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product; or

(2) A product and process of use of said product; or

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

In this case, the products and methods recited in Groups I-V, respectively, do not appear to be within any of the combinations of categories listed above, thus a lack of unity of invention is permitted.

DECISION

For these reasons, the petition filed on 1 January 2008 is **DENIED.**

Applicants remain under obligation to timely response to the Office action mailed 3 September 2008.

Any request for reconsideration should be filed with two (2) months of the mail date of this decision.

Should there be any questions regarding this decision, please contact Special Program Examiner Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 703-872-9306.

Remy Yucel
Director, Technology Center 1600